

REMARKS

This response follows a Decision on Appeal mailed September 26, 2005.

Claim 1 is amended herein without prejudice and without acquiescence solely to further the prosecution of this case, and support for the amendment is in the specification at page 8, line 18-page 9, line 2 and FIG. 7. New claims 12-15 are added herein and find support in the specification at page 8, line 18-page 9, line 2; FIG. 7; and the original claims. No new matter is entered herein.

Issues Under 35 USC §103(a)

Claims 1, 7-9, and 11 were rejected under 35 USC §103(a) as allegedly being unpatentable over Mehta *et al.* (1997) in view of Flavell *et al.*

Claims 1, 5-9, and 11 were rejected under 35 USC §103(a) as allegedly being unpatentable over Mehta *et al.*, 1997 and Flavell *et al.* as applied to claims 1, 7-9, and 11 above and further in view of Mehta *et al.* (1994).

Given the nature of these rejections and the overlap in claims being rejected, Applicants address both rejections simultaneously. Applicants respectfully assert that the Examiner has failed to make a *prima facie* case in light of the amended claims, particularly given that the amended claims concerning drug-resistant leukemias are not taught or suggested in any of the references or combinations thereof.

A skilled artisan looks at the reference and does what he is told from the reference. *Life Technologies, Inc. v. Clontech Laboratories, Inc.*, 224 F.3d 1320, 56 U.S.P.Q.2d 1186 (Fed. Cir. 2000), citing *The Standard Oil Co. v. American Cyanamid Company*, 774 F.2d 448, 227 U.S.P.Q. 293 (Fed. Cir. 1985). There is no suggestion in the references alone or in combination to try the compound for leukemias that are resistant to drugs, such as adriamycin, and one of skill in the art is not told or suggested to utilize the compound for drug-resistant leukemias.

Moreover, if the Applicant adequately traverses the Examiner's assertion of official notice, the Examiner must provide documentary evidence in the next Office Action if the

rejection is to be maintained. See 37 CFR §1.104 (c)(2) and *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697. If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR §1.104(d)(2).

Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc.* 73 F.3d 1085, 37 USPQ2d 1237 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996). To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). There must be a teaching or suggestion to make the claimed limitations, and Applicants remind the Examiner that the level of skill in the art cannot be relied upon for suggestion. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Thus, Applicants assert that the Office has not established a *prima facie* case of obviousness to reject the claims under 35 U.S.C. §103. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, (Fed. Cir. 1991).

Where applicable, the findings ***should clearly articulate which portions of the reference support any rejection.*** Explicit findings on motivation or suggestion to select the claimed invention should....be articulated in order to support a 35 U.S.C. 103 ground of rejection. *In re Dillon*, 919 F.2d at 693, 16 USPQ2d at 1901; *In re Mills*, 916 F.2d 680,683, 16 USPQ2d 1430,1433 (Fed. Cir. 1990). Obviousness can not be based on “common knowledge and common sense of a person of ordinary skill in the art without any ***specific hint or suggestion in a particular reference.***” *In re Lee* 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is not obvious to employ the compositions of the invention to treat drug-resistant leukemias, and there is no teaching or suggestion to employ the methods for treating drug-resistant leukemias. Applicants respectfully request withdrawal of the rejection.

In view of the above amendment and remarks, Applicants believe the pending application is in condition for allowance.

Applicant believes no fee is due with this response other than the fee for one dependent claim. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. AH-CLFR:185US from which the undersigned is authorized to draw.

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Respectfully submitted,

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